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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,219	07/27/2001	Yury Shapiro	07066-065001	6829
22434	7590	05/07/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			MERLINO, AMANDA H	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	
			2877	

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,219

Applicant(s)

SHAPIRO ET AL.

Examiner

Amanda H Merlino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/27/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Examiner's comments

In response to applicant's response dated 11/17/03 regarding the last Office action, the following corrective action is taken.

The period for reply of 3 MONTHS set in said Office Action is restarted to begin with the mailing date of this letter.

The reference DePalma et al (4,120,585) was not correctly cited in the last Office action. The correct citation was listed in the 1449 submitted by applicant on 6/3/03.

A corrected copy of the last Office Action is enclosed.

This action was made final because the new grounds of rejection were necessitated by a new information disclosure statement provided by the applicant as stated below.

Drawings

Figures 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 14, 16-18 rejected under 35 U.S.C. 102(b) as being clearly anticipated by DePalma et al (4,120,585).

DePalma et al teach of a fingerprint detecting device comprising an optical plate (12) made of material with a refraction index of 1.412, a light source (30) and a sensor positioned to receive light collected from the finger.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over DePalma et al (4,120,585).

DePalma et al teach of a fingerprint detecting device comprising an optical plate (12) made of material with a refraction index of 1.412, a light source (30) and a sensor positioned to receive light collected from the finger.

DePalma et al lack the teaching of the optical plate material being silicone or TPX or Butyrate.

At the time of the invention it would have been obvious to one of ordinary skill in the art to replace silicone with either silicone or TPX or Butyrate since all

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have indices of refraction less than 1.44 and since applicant has not disclosed that use of silicone or TPX or Butyrate solves any stated problem, has any specific benefit, or is for any particular purpose and it appears that the invention would perform equally well as a functional equivalent with Sylgard. Furthermore DePalma et al state that other resilient materials other than Sylgard may be used.

Claims 6-13 and 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Ivanisov et al (WO 01/18741) in view of DePalma et al (4,120,585).

Ivanisov et al teach of a thin prism fingerprint imager system comprising a prism with a first surface for receiving a finger, a second surface for a light source, a third surface having a reflective surface (240) and a fourth surface for the imaging system.

Ivanisov lacks the teaching of the prism being made out of a material with an index of refraction less than 1.49.

De Palma et al teach of a prism in a fingerprint detecting device having a refractive index of 1.412.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to replace the prism in the apparatus taught by Ivanisov with the prism having an index of refraction of 1.412 to provide a more pliable prism which "provide wider ridges which allow a better discrimination of details" as taught by DePalma et al.

With reference to claims 19-20, the method of forming an optical plate, the claims appear to contain no patentable steps in manufacturing an optical plate,

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however if applicant believes that the method steps are novel, examiner will considering examining the claims after an election in reply to a restriction.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 10/28/02 and 6/3/03 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maase et al (5,528,355) and Sarto (6,175,407) and Suga(6,115,483) teach of fingerprinting devices wherein the optical plate contains material with a refractive index less than 1.44.

Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax Machine located in Crystal Plaza 4. The form of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is:

(703) 872-9306

If the applicant wishes to send a Fax dealing with a Proposed Amendment for discussion for a phone interview then the fax should:

1) Contain either the statement "DRAFT" or "PROPOSED AMENDMENT" on the Fax Cover Sheet; and


2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Examiner Amanda H. Merlino* whose telephone number is (571)272-2421. The examiner can be reached on Mondays and Thursdays only.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-0956.

Amanda H. Merlino *ah*
Patent Examiner
Art Unit 2877
April 28, 2004/ahm



FRANK G. FONT
SUPERVISORY PATENT
EXAMINER